

REMARKS

The present application has been considered in view of the Office Action that was mailed on August 11, 2010. Claims 1-35 are currently pending. By the present Amendment, Applicant has amended independent claims 1, 19, and 31. Applicant respectfully submits that the amendments to independent claims 1, 19, and 31 effected herein do not introduce any new matter, and are fully supported by the application. In view of the following remarks and arguments, Applicant respectfully submits that each of pending claims 1-35 is allowable over the references of record, and accordingly, respectfully requests reconsideration and allowance of these claims.

In the Office Action, claims 1-5, 7-9, 12-16 and 18-35 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,215,521 to Cochran, *et al.* (hereinafter "Cochran") in view of U.S. Patent No. 4,886,509 to Mattsson (hereinafter "Mattsson").

Applicant respectfully submits, however, that the combination of Cochran and Mattsson fails to render the subject matter of claims 1-5, 7-9, 12-16, and 18-35 obvious, as presented herein.

As a condition for patentability, 35 U.S.C. §103(a) indicates that "if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art," then the subject matter is not patentable. (Emphasis added).

As amended, independent claim 1 recites “[a] tissue removal device” that includes, *inter alia*, a bag “having folds including at least one transverse fold” that is repositionable between unfolded position and folded conditions:

whereby a length of the bag extending in a direction parallel to the longitudinal axis of the shaft is increased and distal portion of the tissue removal device defines a reduced transverse cross-sectional dimension, when the bag is in the folded position, less than a transverse cross-sectional dimension otherwise defined by the distal portion of the tissue removal device including a like bag, in a folded position, devoid of said at least one transverse fold. (Emphasis added).

As amended, independent claim 19 recites “[a] method of collapsing a bag of a tissue removal device” that includes the steps of, *inter alia*, providing a tissue removal device with a bag that is repositionable between unfolded and folded positions, and:

folding the bag transversely with respect to the longitudinal axis such that a first transverse fold is formed . . . whereby a length of the bag extending in a direction parallel to the longitudinal axis of the shaft is increased and a distal portion of the tissue removal device defines a reduced transverse cross-sectional dimension, when the bag is in the folded position, less than a transverse cross-sectional dimension otherwise defined by the distal portion of the tissue removal device including a like bag, in a folded position, devoid of said at least one transverse fold. (Emphasis added).

Independent claim 28, as previously presented, recites “[a] minimally invasive tissue removal device” that includes, *inter alia*, a bag that is repositionable between unfolded and folded positions, wherein the bag is:

folded over onto itself so as to form at least one transverse fold . . . such that an axial length of the bag assembly is increased and a distal portion of the tissue removal device defines a reduced transverse cross-sectional dimension, when the bag is in the folded position, that is relatively smaller as compared to a distal portion of the tissue removal device including a like bag, in a folded position,

that is devoid of said at least one transverse fold. (Emphasis added).

As amended, independent claim 31 recites “[a] minimally invasive tissue removal device” that includes, *inter alia*, a bag that is repositionable between unfolded and folded positions, wherein:

the bag is folded over onto itself so as to form at least one fold extending along an axis that is substantially non-parallel and non-orthogonal to the longitudinal axis of the shaft, whereby a length of the bag extending in a direction parallel to the longitudinal axis of the shaft is increased and a distal portion of the tissue removal device defines a reduced transverse cross-sectional dimension, when the bag is in the folded position, less than a transverse cross-sectional dimension otherwise defined by the distal portion of the tissue removal device including a like bag, in a folded position, devoid of said at least one transverse fold. (Emphasis added).

Independent claim 33, as previously presented, recites “[a] method of collapsing a bag of a tissue removal device” comprising the step of, *inter alia*, “providing a minimally invasive tissue removal device” that includes “a bag assembly” having “a shaft defining a longitudinal axis,” “a bag support disposed at a distal end of the shaft,” and “a bag attached to the bag support, the bag being repositionable between an unfolded position, in which the bag assembly defines an initial longitudinal dimension, and a folded position, in which the bag assembly defines a subsequent longitudinal dimension, the subsequent longitudinal dimension being greater than the initial longitudinal dimension.” (Emphasis added).

Cochran relates to “laparoscopic organ retrieval apparati and procedures for minimally invasive surgery dealing with intra-abdominal or other body cavity surgery,” as well as “to an improved method and apparatus of organ entrapment and effective fragmentation-evacuation of the dissected and entrapped organ,” and “laparoscopic [*sic*] organ retrieval apparati and

procedures for containment, dissection, morsellation of substantially solid organs such as kidneys utilizing minimal invasive surgery.” (Col. 1, lines 6-16).

In one embodiment of the disclosure, Cochran describes an organ retrieval apparatus including an entrapment envelope 22 that is inserted into an inflated body cavity through an elongate sheath 20. (See col. 8, lines 12-18; FIG. 4 reproduced below).

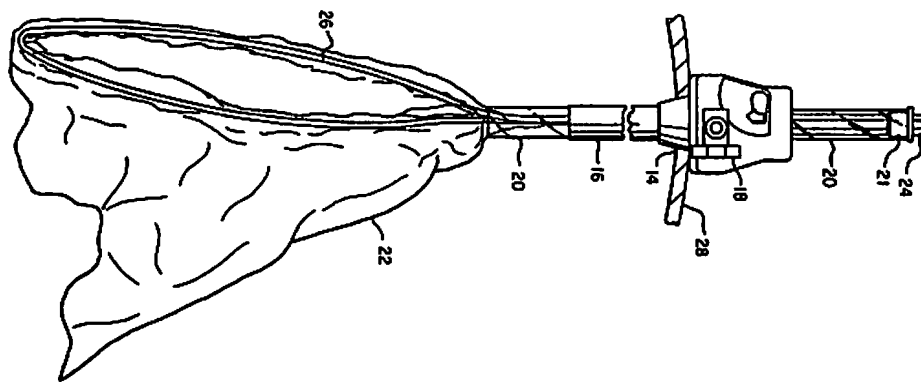
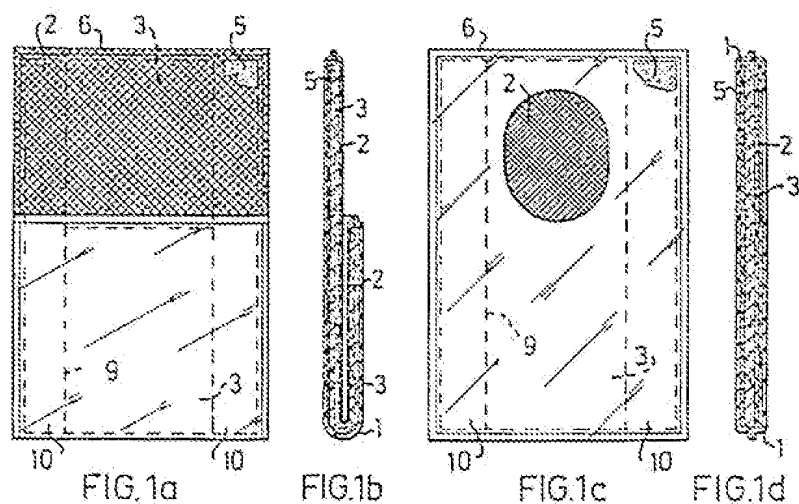


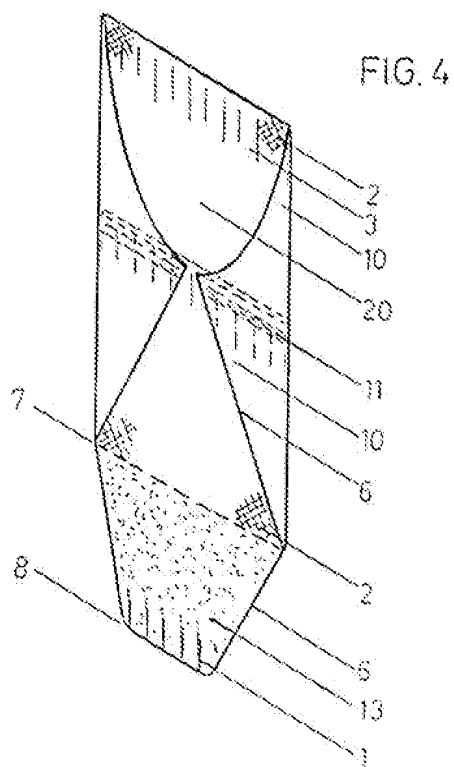
FIG. 4

Mattsson relates to “a device for collecting and absorbing urine,” and more specifically, to “a device comprising a laminate composed of several layers, in which an outer plastic casing in combination with a material permeable to urine, e.g., a non-woven material, form a space enclosing an absorption body.” (Col. 1, lines 12-17).

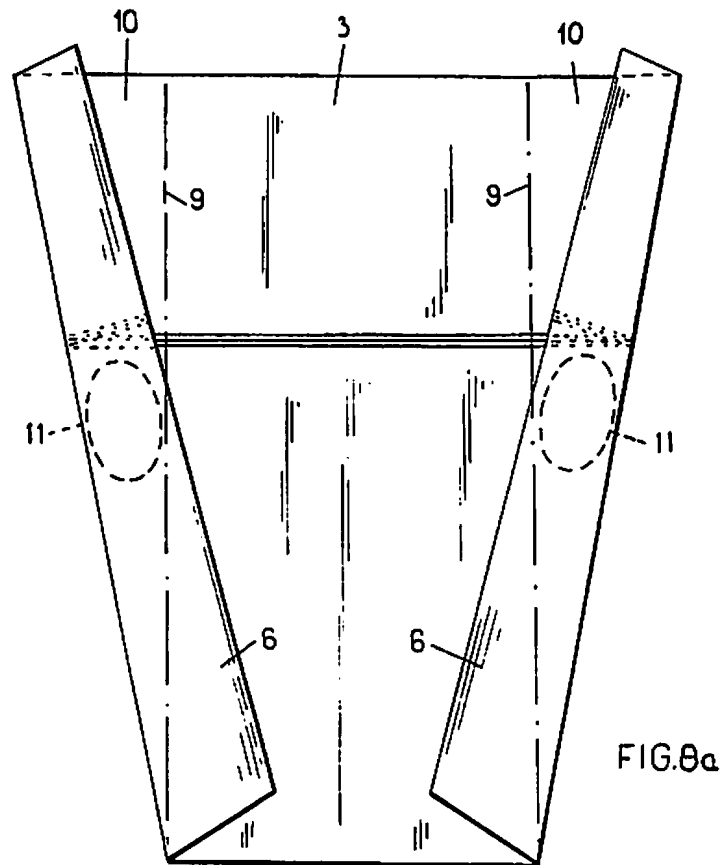
In one embodiment of the disclosure, Mattsson describes a device includes an outer plastic casing 1, a material 2 permeable to urine, an absorption body 3, an optional outer material 4 permeable to urine, and a super-absorbent laminated layer 5. (See col. 2, lines 62-67; FIGS. 1a-1d below).



According to Mattsson, the disclosed device “may have an overlapping tab 20 and a transverse fold 7 for the material 2 permeable to urine and a transverse fold 8 for the plastic casing 1.” (Col. 2, lines 62-67; FIG. 4 below).



In another embodiment, the Mattsson device includes flaps 10 that extend along the entire length of side edges 9 of the absorption body 3. (See col. 4, lines 59-62; FIG. 8a below).



In the Office Action, the entrapment envelope 22 described in Cochran was characterized as the “bag” recited in claims 1-5, 7-9, 12-16, and 18-35. (See Office Action, page 2). While it was argued that the Cochran envelope 22 is capable of folding transversely, it was acknowledged that the envelope 22 fails to include the at least one transverse fold also included as part of the claimed subject matter, and Mattsson was relied upon for disclosure of this concept with

reference to the embodiment of the disclosed device seen above in FIG. 8a. (*See* Office Action, pages 3-4).

As can be appreciated through reference to FIGS. 4 and 8a of Mattsson above, in each embodiment of the disclosed device, upon folding, the dimensions of the device are reduced.

In contrast, as set forth above, each of independent claims 1, 19 and 31 have been amended to substantially recite, *inter alia*, that the bag is folded over onto itself such that “a length of the bag extending in a direction parallel to the longitudinal axis of the shaft is increased.” (Emphases added).

Similarly, as previously presented, independent claim 28 recites, *inter alia*, that the bag is folded over onto itself so as to form at least one transverse fold . . . such that an axial length of the bag assembly is increased, and independent claim 33 recites, *inter alia*, that the bag assembly defines a subsequent longitudinal dimension, the subsequent longitudinal dimension being greater than the initial longitudinal dimension.” (Emphases added).

Consequently, Applicant respectfully submits that Mattsson fails to remedy the deficiencies in Cochran acknowledged in the Office Action.

Accordingly, and for at least this reason, *inter alia*, Applicant respectfully submits that neither Cochran, nor Mattsson, nor any proper combination thereof, suggests the subject matter of independent claims 1, 19, 28, 31, and 33 as a whole, as presented herein, and therefore, that the combination of Cochran and Mattsson fails to render the subject matter of these claims

obvious. As such, Applicant respectfully submits that independent claims 1, 19, 28, 31, and 33 are allowable over Cochran in view of Mattsson under 35 U.S.C. §103(a).

Since claims 2-5, 7-9, 12-16, 18, 20-27, 29, 30, 32, 34, and 35 depend either directly or indirectly from one of independent claims 1, 19, 28, 31, and 33, and include each element recited therein, for at least the reasons that independent claims 1, 19, 28, 31, and 33 are allowable over Cochran in view of Mattsson under 35 U.S.C. §103(a), *inter alia*, Applicant respectfully submits that the subject matter of claims 2-5, 7-9, 12-16, 18, 20-27, 29, 30, 32, 34, and 35, as a whole, is also allowable over Cochran in view of Mattsson under 35 U.S.C. §103(a).

Claims 1, 4, and 6 were rejected under 35 U.S.C. §103(a) as being unpatentable over Cochran in view of Mattsson, and further in view of U.S. Patent No. 5,899,694 to Summer (hereinafter “Summer”).

Applicant respectfully submits that the combination of Cochran, Mattsson, and Summer fails to render the subject matter of claims 1, 4, and 6 obvious, as presented herein.

In the Office Action, it was acknowledged that the combination of Cochran and Mattsson fails to disclose “a sheath disposed about the bag assembly,” as recited in claim 4, or a “sheath” that is “fabricated from a flexible heat shrinking polymer,” as recited in claim 6, but Summer was relied upon for disclosure of this concept.¹ (*See* Office Action, pages 4-5).

¹ Applicant believes claim 1 to have been inadvertently included in the rejection under 35 U.S.C. §103(a) over Cochran in view of Mattsson and Summer, in that independent claim 1 does not recite the “sheath” purportedly disclosed in Summer. In the interests of responding fully to the rejection, however, Applicant will overlook the inclusion of claim 1, and the rejection will be addressed with respect to claims 1, 4, and 6.

As discussed above, the combination of Cochran and Mattsson fails to suggest the subject matter of amended independent claim 1 as a whole. Assuming, *arguendo*, that the characterization of Summer proffered in the Office Action is accurate, and that Cochran, Mattsson, and Summer are properly combinable under the MPEP, including the “sheath” purportedly disclosed in Summer would fail to cure the aforescribed deficiency in the combination of Cochran and Mattsson.

Accordingly, and for at least this reason, *inter alia*, Applicant respectfully submits that the combination of Cochran, Mattsson, and Summer fails to suggest the subject matter of amended independent claim 1 as a whole, and therefore, that the combination of Cochran, Mattsson, and Summer fails to render the subject matter of amended independent claim 1 obvious. Accordingly, Applicant respectfully submits that amended independent claim 1 is allowable over Cochran in view of Mattsson and Summer under 35 U.S.C. §103(a). Since claims 4 and 6 depend directly and indirectly from amended independent claim 1, respectively, and include each element recited therein, for at least the reasons that amended independent claim 1 is allowable over Cochran in view of Mattsson and Summer under 35 U.S.C. §103(a), *inter alia*, Applicant respectfully submits that claims 4 and 6 are also allowable over Cochran in view of Mattsson and Summer under 35 U.S.C. §103(a).

Claims 10 and 11 were rejected under 35 U.S.C. §103(a) as being unpatentable over Cochran in view of Mattsson, and further in view of U.S. Patent No. 6,402,722 to Snow *et al.* (hereinafter “Snow”).

Applicant respectfully submits, however, that the combination of Cochran, Mattsson, and Snow fails to render the subject matter of claims 10 and 11 obvious, as presented herein.

In the Office Action, it was acknowledged that the combination of Cochran and Mattsson fails to disclose “a cord operatively connected to the tear line for facilitating the tearing of the sheath along the tear line,” as recited in claim 10. However, the Examiner relies on the teachings of Snow for the disclosure of this concept. (*See* Office Action, page 5)

As previously discussed, the combination of Cochran and Mattsson fails to suggest the subject matter of amended independent claim 1 as a whole. Assuming, *arguendo*, that the characterization of Snow proffered in the Office Action is accurate, and that Cochran, Mattsson, and Snow are properly combinable under the MPEP, including the “cord” purportedly disclosed in Snow would fail to cure the aforescribed deficiency in the combination of Cochran and Mattsson.

Accordingly, and for at least this reason, *inter alia*, Applicant respectfully submits the combination of Cochran, Mattsson, and Snow fails to suggest the subject matter of amended independent claim 1 as a whole, and therefore, that the combination of Cochran, Mattsson, and Snow fails to render the subject matter of amended independent claim 1 obvious. As such, Applicant respectfully submits that amended independent claim 1 is allowable over Cochran in view of Mattsson and Snow under 35 U.S.C. §103(a).

Since claims 10 and 11 depend indirectly from amended independent claim 1, and include each element recited therein, for at least the reasons that amended independent claim 1 is

allowable over Cochran in view of Mattsson and Snow under 35 U.S.C. §103(a), *inter alia*, Applicant respectfully submits that the subject matter of claims 10 and 11, as a whole, is also allowable over Cochran in view of Mattsson and Snow under 35 U.S.C. §103(a).

Claim 17 was rejected under 35 U.S.C. §103(a) as being unpatentable over Cochran in view of Mattsson, and further in view of U.S. Patent No. 5,480,404 to Kammerer, *et al.* (hereinafter “Kammerer”).

Applicant respectfully submits, however, that the combination of Cochran, Mattsson, and Kammerer fails to render the subject matter of claim 17 obvious, as presented herein.

In the Office Action, it was acknowledged that the combination of Cochran and Mattsson fails to disclose a “bag” that is “trapezoidal in shape,” as recited in claim 17. However, the Examiner relies on the teachings of Kammerer for the disclosure of this concept. (*See* Office Action, page 6).

As previously discussed, the combination of Cochran and Mattsson fails to suggest the subject matter of amended independent claim 1 as a whole. Assuming, *arguendo*, that the characterization of Kammerer proffered in the Office Action is accurate, and that Cochran, Mattsson, and Kammerer are properly combinable under the MPEP, including the “trapezoidal bag” purportedly disclosed in Kammerer would fail to cure the aforescribed deficiency in the combination of Cochran and Mattsson.

Accordingly, and for at least this reason, *inter alia*, Applicant respectfully submits that the combination of Cochran, Mattsson, and Kammerer fails to suggest the subject matter of

amended independent claim 1 as a whole, and therefore, that the combination of Cochran, Mattsson, and Kammerer fails to render the subject matter of amended independent claim 1 obvious. As such, Applicant respectfully submits that amended independent claim 1 is allowable over Cochran in view of Mattsson and Kammerer under 35 U.S.C. §103(a).

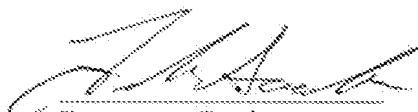
Since claim 17 depends directly from amended independent claim 1, and includes each element recited therein, for at least the reasons that amended independent claim 1 is allowable over Cochran in view of Mattsson and Kammerer under 35 U.S.C. §103(a), *inter alia*, Applicant respectfully submits that the subject matter of claim 17, as a whole, is also allowable over Cochran in view of Mattsson and Kammerer under 35 U.S.C. §103(a).

In view of the foregoing remarks and arguments, Applicant respectfully submits that each of pending claims 1-35 is allowable over the references of record, as presented herein, and accordingly, respectfully requests reconsideration and allowance of these claims.

Should the Examiner have any questions concerning the present Amendment, or feel that an interview would be helpful in resolving any outstanding matters, the Examiner is sincerely invited to contact Applicant's undersigned attorney whenever convenient.

Please charge any deficiency, as well as any other fee(s) which may become due under 37 C.F.R. §1.16 and/or 1.17 at any time during the pendency of this application, or credit any overpayment of such fee(s), to Deposit Account No. 50-2140. Also, in the event any extensions of time for responding are required for the pending application(s), please treat this paper as a petition to extend the time as required, and charge Deposit Account No. 50-2140 accordingly.

Respectfully submitted,



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